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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,613	01/15/2004	Ruupak Nanyamka Omar	0103281/0515640	6346
26874	7590	11/23/2005	EXAMINER	
FROST BROWN TODD, LLC 2200 PNC CENTER 201 E. FIFTH STREET CINCINNATI, OH 45202			LOWEN, ALYSSA	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/758,613	Applicant(s) OMAR, RUUPAK NANYAMKA	
	Examiner Alyssa M. Lowen	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/15/04 & 10/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II (claims 9-22) in the reply filed on 10/13/04 is acknowledged. The traversal is on the ground(s) that the two groups of claims are required to be both independent and distinct and the groups are not distinct because they disclose a single subject. Examiner notes that it has been long established that dependent inventions may be properly divided if they are "distinct" inventions, even though dependent. See MPEP 802.01. In this case the two groups are distinct because they are recognized divergent subject matter. The subject of group one is a process of making and the subject of group two is a novelty article. The requirement is still deemed proper and is therefore made FINAL.
2. Claims 1-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/13/04.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 1/15/04 and 10/13/04 are in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

Priority

4. Applicant's claim for the benefit of a prior-filed provisional application (60/446478) under 35 U.S.C. 119(e) is acknowledged. Applicant has complied with all conditions for receiving the benefit of an earlier filing date.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the head of the figurine being hollow and the figurine positioned in the head, the face being a caricature, the voice signal technology, the face being textured similar to the related object, the openable cavity with removable item, the article being reversible, and the article combined with a pillow or backpack must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: On page 8 lines 14-15 the statement "three right side" is used where "the left side" was probably meant. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is unclear as to if the representation of the face and object are proportional to one another to make up the head of an athlete or the actual size of the object is the same as the athlete's head.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 9-11, 15, 17-18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson (5511685). Regarding claim 9, Nelson discloses a sports novelty article in the form of a mug having a three-dimensional representation of the face of a famous athlete in the form of a photograph (column 3 lines 11-15) positioned on a three-dimensional representation of an object related to the sport the famous athlete is from such as a helmet (Fig. 3). In regard to claim 10 the combined representation of the face and related object form the head of a figurine (Fig. 3). Regarding claim 11 the figurine depicts the famous athlete's helmet or uniform (column 4 lines 26-27). In regard to claim 15 the helmet has decals, logos and names to make the helmet recognizable as belonging to a particular person (column 4 lines 28-34). With regard to claims 17 and 18 the mug has an openable cavity (44) for removably storing beverage containers therein (column 3 lines 55-58). Regarding claim 21 the face and object are proportional in size so as to create the head of the athlete (Fig. 3).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 9, 12-14, 16, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash (6517406) and Burton (D394479) and further in view of official notice. With regard to claims 9 and 22, the device of Cash discloses the basic inventive concept of a sports novelty article having a face (48) positioned on a three-dimensional

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representation of an object associated with a sport such as a baseball where the ball forms the remainder of the head (Fig. 1), with the exception of the face being a three-dimensional representation of a famous athlete. Burton discloses a ball shaped doll having three-dimensional facial features and a ball that is generally the size of the represented head (Fig. 2) showing this quality to be old in the ball figurine art. It would have been obvious to one of ordinary skill in the art to have the face of Cash display three-dimensional characteristics in order to have a doll with more realistic looking features. Official notice is taken that it is well known in the doll art to have the face of a doll resembling a famous person, athlete or celebrity, as such it would have been obvious to include this feature to increase the amusement value of the toy since it would be in a form that was well known and easily recognizable to a child. Regarding claim 14, as seen by Burton the face is made integrally with the ball and therefore of the same material giving it the same texture (Fig. 1).

13. Regarding claim 12 the above references do not disclose the head of the figurine being hollow so that the figurine can be positioned in the head. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the head portion of the doll be hollow because Applicant has not disclosed that the head being hollow provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the head being stuffed because it would provide a safe and soft toy.

14. Regarding claim 13 the above references do not disclose the face of the athlete being a caricature. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the face be a caricature because Applicant has not disclosed that a caricature provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the standard facial features because it would the face of the famous person would be more easily recognizable.

15. Regarding claim 16, official notice is taken that it is well known in the doll art to use voice signal technology, as such it would have been obvious to include this feature to create a more interesting and interactive toy.

16. Regarding claim 19 the above references do not disclose the article being reversible to reveal a second face. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the article be reversible because Applicant has not disclosed that reversibility provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with only one face because multiple faces are not needed for using and enjoying the toy. The number of faces on the article is merely a matter of user preference and is entirely obvious.

17. Regarding claim 20 the above references do not disclose the novelty article being combined with a pillow or backpack. At the time the invention was made, it would

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have been an obvious matter of design choice to a person of ordinary skill in the art to have the doll attached to a pillow or backpack because Applicant has not disclosed that the combination with a pillow or backpack provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well without a pillow or backpack because it can be used as a toy or ball not just a decorative piece.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EUGENE KIM
PRIMARY EXAMINER

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